

In the Office Action the Examiner contends that the specification is not enabling under §112 with respect to how the reticle sorter protects the reticles from foreign particles, orients the reticles and stabilizes the reticles during the sorting process (Paper 9, page 2). The Examiner further contends that to be enabling the specification must allow any person skilled in the art to make and use the invention without undue experimentation. Applicants respectfully traverse the §112 rejection. The Examiner has concluded that Applicants must resolve “critical issues” of semiconductor fabrication for the specification to be enabling (Paper 9, page 2). However, these “critical issues” have long been resolved in semiconductor fabrication, as evidenced by the Examiner’s own acknowledgment that the cited references have “disclosures that contain considerable detail for each specific method of reticle handling” (Paper 9, page 3). In addition, the Examiner has acknowledged that Applicants’ specification “teaches how to resolve the critical issues on an elementary level” (Paper 9, page 2). No evidence is provided by the Examiner that the Applicants do not enable reticle handling. In addition to these acknowledgments by the Examiner, the record further evidences that the claimed invention is enabled by the cites to the specification as discussed in the previous Office Action Response. Accordingly, the only evidence in the record in regard to the enablement issue is in support of Applicants’ position.

Moreover, regarding the previous Office Action Response, the Examiner has failed to comply with MPEP§707.07(f) in not explaining why these cites to the specification do not adequately overcome the enablement rejection. Any new argument presented by the Examiner going forward, in support of his stated conclusions, would be considered a new ground of rejection that would re-open prosecution in this case. In view of the foregoing, Applicants maintain that the specification as written is enabling and provides sufficient support for the claimed invention.

Applicants respectfully traverse the rejection of claims 1, 8, 11 and 19 based on second paragraph of §112. In particular, the basis for the Examiner’s rejection is that Applicants use of the term “adapted” renders the claims indefinite and the term does not have a clear technical meaning. Applicants contend that “adapted” is clear and has come to be a commonly used term in claiming an invention. A brief review of the U.S. Patent Office’s own database, from 1991 to 2001, indicate that the term “adapted” has been used in the claims of over 162,000 issued patents. In view of the foregoing, Applicants contend that the scope of the claims are ascertainable and therefore the §112 should be withdrawn.

Regarding the various §103 rejections of the claims, Applicants respectfully submit that rejections were properly addressed in Applicants' response dated February 20, 2001. However, with respect to the *Iizuka/Sussman* combination, Applicants do take issue with the Examiner's position that "a stated motivation need not be explicit in the cited art to exist as a motivation" (Paper 9, page 4). Applicants' note, as indicated in the requirements set forth by the Federal Circuit in such cases as *Ruiz v. A.B. Chance Co.*, (Fed. Cir., December 6, 2000), that the alleged motivation for combining the references is to be suggested by the *references* ("Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'"). In view of the *Ruiz* case, the alleged motivation provided by the Examiner for combining the *Iizuka* and *Sussman* references is not evidenced in the cited *references* nor do these *references* indicate a special interest or importance to those skilled in the art. In addition, there is no evidence that those skilled in the art would seek the asserted *references* for possible solutions of the problem to be solved. In view of the foregoing, and in view of Applicants' previous response addressing all of the obviousness rejections in detail, Applicants contend that the obviousness rejections of the claims should be withdrawn.

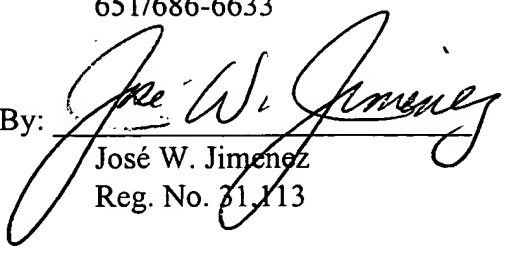
In view of the remarks above, Applicants believe that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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By:

  
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